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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,892	12/01/2000	Jerry Pelletier	073406-0302	3660

7590  
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07/24/2002

EXAMINER

PORTNER, VIRGINIA ALLEN

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 07/24/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/727,892

Applicant(s)

Pelletier et al

Examiner

Partner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 1, 2000
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-110 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-110 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

Claims 1-110 are pending.

#### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 18-22, 25-27 and 28-29, drawn to a plurality of viral nucleic acids, to include vectors, host cells that comprise an open reading frame or an open reading frame fragment, classified in class 536, subclass 23.1.
  - II. Claims 23-24, 62-66, 107-110, drawn to proteins and peptides, classified in class 530, subclass 300.
  - III. Claims 1-6, 9-17, 32-38, 39-40, 77-106 drawn to a method of identifying antibacterial agent, classified in class 435, subclass 5.
  - IV. Claims 7-8, drawn to a method of identifying a mutated bacterial coding sequence, classified in class 536, subclass 24.32.
  - V. Claims 41-61, drawn to a method of inhibiting, treating or preventing infection, classified in class 424, subclass 204.1.
  - VI. Claims 67-70, drawn to a method of making an antibacterial agent, classified in class 514, subclass 2.
  - VII. Claims 71-76, drawn to an antibody and a method of using the antibody to detect a viral product, classified in class 435, subclass 7.1.

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2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions Group I and Group II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case, that the product as claimed can be made by another and materially different apparatus, the protein or peptide can be produced by synthetic methods, or purified from a natural source.

4. Inventions Group I and Group III, Group IV, Group V, or VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product, wherein the nucleic acid product can be used in method of inhibiting a bacteria, in method of producing a protein or peptide, in methods of identifying an antibacterial agent, in a method of making an antibacterial agent, wherein each method utilizes different reagents and methods steps in using the nucleic acid product.

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5. Inventions Group II and Group VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group II has separate utility such as in a method of purifying antibodies, in detecting viral antibodies in a host, in the production of molecular image polymers, and in methods of detecting antibacterial agents. See MPEP § 806.05(d).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. This application contains claims directed to the following patentably distinct inventions:

a. Group I, is directed to independent and distinct open reading frames, each encoding a structurally and functionally different product, specifically :

open reading frame 12 ;and

open reading frame 25 .

b. Group II, is directed to polypeptides that encoded by independent and distinct open reading frames, each encoding a structurally and functionally different product, specifically:

open reading frame 12; and

open reading frame 25 .

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c. Group III, is directed to methods of utilizing independent and distinct open reading frames, each encoding a structurally and functionally different product, specifically:

open reading frame 12; and

open reading frame 25 for identifying antibacterial agents.

d. Group IV, is directed to methods of utilizing independent and distinct open reading frames, each encoding a structurally and functionally different product, specifically:

open reading frame 12; and

open reading frame 25 for identifying mutated bacterial coding sequences.

e. Group V, is directed to methods of utilizing proteins, peptides or peptide mimics that are active compounds on a target of a bacteriophage open reading frames, each encoded by structurally and functionally different sequences, specifically:

open reading frame 12 encoded peptide; and

open reading frame 25 encoded a peptide for identifying antibacterial agents.

f. Group VI, is directed to methods of making agents which are active compounds on a target of a bacteriophage open reading frames, each agent interacting with a bacterial target molecule that also interacts with a bacterial product encoded by structurally and functionally different sequences, specifically: open reading frame 12; and

open reading frame 25 for identifying antibacterial agents.

The agents having been identified based upon the interaction of the bacteriophage open reading

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frame or portion of the open reading frame, which is then synthesized to obtain the identified agent.

g. Group VII, is directed to methods that bind to viral products encoded by open reading frame (ORF) 12 or 25 and are used in methods of detecting either the production of:

OPR 12; and

OPR25.

8. Applicant is required to elect a single disclosed invention for prosecution on the merits.

9. Applicant is advised that a reply to this requirement must include an identification of the elected invention consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

**General Observations:**

12. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. See page 59, lines 26-30 and page 60, lines 1-9.

13. The instant specification refers to Tables 1-8. Where are Tables 1-8 in the specification? (Page 30, lines 25-30 and page 31, lines 1-17).

**Brief Description of the Drawings:**

a. Each Brief Description should refer to the frames shown in each figure. ie. 1A, 1B & 1C.

b. It was noted that Figures 1,2,5 and 5 all evidence a plurality of frames that should be designated by reference indicators such as A, B, C or 5B-1, 5B-2, etc.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginny Portner whose telephone number is (703)308-7543. The examiner



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can normally be reached on Monday through Friday from 7:30 AM to 5:00 PM except for the first Friday of each two week period.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909. The fax phone number for this group is (703) 308-4242.

The Group and/or Art Unit location of your application in the PTO will be Group Art Unit 1645. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to this Art Unit.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Vgp

July 22, 2002

  
LYNETTE R. F. SMITH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600